

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed October 31, 2007 ("Office Action"). Claims 1-39 are pending in the present application and currently stand rejected.

Procedural History

This Final Office Action is the eleventh action on the merits for this application. The PTO's initial rejection was based primarily on U.S. Patent No. 5,983,273 issued to White et al. ("*White*"). Applicants' made some amendments and the PTO asserted a new rejection based primarily on U.S. Patent No. 5,974,566 issued to Ault, et al. ("*Ault*"). Applicants' made some minor amendments and then the PTO asserted a new rejection based primarily on U.S. Patent No. 6,477,708 issued to Sawa et al. ("*Sawa*"). Applicant's argued that the independent claims were allowable over *Sawa* and the PTO asserted a new rejection based on *Ault*, again. Applicants' argued that the independent claims were allowable over *Ault* and several rounds of disagreement ensued as to the allowability of the independent claims over *Ault* until the PTO asserted a new rejection based primarily on U.S. Publication No. 2006/0106703 A1, listing Del Rey, et al. as inventors ("*Del Rey*"). Applicants' argued that the independent claims were allowable over *Del Rey* and questioned whether *Del Rey* was, in fact, prior art. Several rounds of disagreement ensued as to the allowability of the independent claims over *Del Rey*, including Applicants filing a pre-appeal brief. The pre-appeal decision withdrew the rejection and re-opened prosecution. After the pre-appeal reversal, the PTO asserted a new rejection based primarily of U.S. Patent No. 6,760,759 to Chan ("*Chan*").

Given the number of actions to this point, Applicants, thorough its attorney, Ryan S. Loveless (Reg. No. 51,970), interviewed Examiner Aravind K. Moorthy on August 21, 2007 ("Examiner Interview"). Applicants respectfully submitted that the claims as they stood were not disclosed by *Chan*. Notwithstanding this, Applicants agreed to a minor amendment, which Examiner Moorthy agreed would make the claims allowable over *Chan*. As shown below, the PTO has asserted another new rejection based on a new reference.

Given the long pendency of this Application and as discussed in the Examiner Interview and requested in the subsequent response, Applicants are amenable to another interview. Applicants re-iterate this request. Additionally, given that this Application has been pending for more than five years and has eleven actions, Applicants request that this Application be considered “special”. See M.P.E.P. §707.02. Applicants additionally request that the PTO carefully reconsider this Application.

Section 102 Rejection

Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, 36, and 37 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,986,157 to Fijolek, et al. (“*Fijolek*”). Applicants traverse this rejection.

As the PTO is aware, in order for a reference to anticipate a claim “[t]he identical invention **must** be shown in as **complete detail** as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (Emphasis Added). Further, Applicants respectfully remind the PTO that “**the particular part relied on** must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 C.F.R. §1.104 (Emphasis added). With these threshold requirement in mind, Applicant submits that the PTO has failed to establish a *prima facie* case of anticipation using *Fijolek*

Independent Claim 1 is allowable because *Fijolek* fails to disclose, expressly or inherently, “initiating a service request message by a first client to a first server, the service request message initiated **after** a **packet-based telephony call session has been established** between the first client and a communication network, the service request message including the first client identity and a requested service available from a second server comprising a plurality of services.” (Emphasis added). The Office Action alleges that *Fijolek* discloses the emphasized features at Col. 34, ll. 17-35, but this is incorrect. Col. 34, ll. 17-35 generally describe a “registration message 342 sent from CM 16 to the CMTS 12.” In this paragraphs, no details are provided as to a service request message initiated **after** a **packet-based telephony call session has been established**. That is, for

example, there is absolutely no discussion in this paragraph that this “registration message” is sent **after a packet-based telephony call session has been established.**

Independent Claim 1 is also allowable because *Fijolek* fails to disclose, expressly or inherently, “delivering the requested service in packet form to the first client **during the established packet-based telephony call session** by the second server in response to determining that the first client is authorized to use the requested service.” The Office Action alleges that Col. 36, l. 63 - Col. 37, l. 12 of *Fijolek* discloses these features, but this is incorrect. Col. 36, l. 63 - Col. 37, l. 12 of *Fijolek* generally describes information that may be included in a registration message, for example, an “offhook” request. Col. 36, l. 63 - Col. 37, l. 12 simply mentions nothing of “delivering the requested service in packet form to the first client **during the established packet-based telephony call session** by the second server in response to determining that the first client is authorized to use the requested service.” More particularly, Col. 36, l. 63 - Col. 37, l. 12. mentions nothing of an **established packet-based telephony call session.**

For at least the above reasons, Applicants submit that a *prima facie* rejection has not been established. *Fijolek* does not disclose the claimed invention in as **complete detail** as is contained in Independent Claim 1. Accordingly, Independent Claim 1 and its dependents should be allowed as should Independent Claims 14, 29, and 36 and their dependents for analogous reasons.

Notwithstanding the above reasons for allowance, many of the dependent claims are also allowable because *Fijolek* fails to teach or suggest the additional limitation or limitations recited by the respective dependent claims. Example are described below.

Claim 2 is also allowable because *Fijolek* fails to disclose “at least one of the services comprises an application operable to provide text viewing and modification capabilities.” With regards to this limitation, the Office Action points to Col. 38, ll. 44-54 of *Fijolek*, but this is incorrect. In pertinent part, this portion discloses the following:

In one exemplary preferred embodiment of the present invention, the service request is a VoIP “onhook” request to terminate a VoIP call. However, other service requests can also be made, and the present invention is not limited to VoIP requests.

(Col. 38, ll. 48-54 of *Fijolek*.). As can be seen from above, clearly there is no disclosure of a service (delivered to a client) that comprises an application operable to provide text

viewing and modification capabilities. Accordingly, for at least this additional reason, Claim 2 is allowable as are Claims 3, 17, and 18 for analogous reasons.

Claim 4 is also allowable because *Fijolek* fails to disclose “the requested service [] only available during the packet-based telephony call session.” With regards to this limitation, the Office Action points to Col. 37, ll. 43-33 of *Fijolek*, but this is incorrect. Col. 37, ll. 43-33 of *Fijolek* simply mentions nothing of a packet-based telephony call session, let alone the requested service being available only during the packet-based telephony call session. Accordingly, for at least this additional reason, Claim 4 is allowable as is Claim 19 for analogous reasons.

Claim 5 is also allowable because *Fijolek* fails to disclose “issuing a ticket to the first client in response to determining that the list includes authorization for the first client to use the requested service.” With regards to this limitation, the Office Action points to Col. 11, l. 33 - Col 12, l. 34 of *Fijolek*, but this is incorrect. Col. 11, l. 33 - Col 12, l. 34 is a table of parameters and description of those parameters. This table simply mentions nothing of tickets, let alone issuing a ticket to the first client in response to determining that the list includes authorization for the first client to use the requested service. Accordingly, for at least this additional reason, Claim 5 is allowable as is Claims 6, 20, 30, 31, and 37 for analogous reasons.

Claim 12 is also allowable because *Fijolek* fails to disclose “pressing a button associated with the requested service at the first client during the packet-based telephony call session to initiate the service request message.” With regards to this limitation, the Office Action points to Col. 34, ll. 11-16 of *Fijolek*, but this is incorrect. Col. 34, ll. 11-16 of *Fijolek* discloses in its entirety the following:

In one embodiment of the present invention, at Step 332, the CMTS 12 receives a registration message from the CM 16. The registration message includes multiple service parameters (e.g., QoS) for a desired service (e.g., Voice over Internet Protocol ("VoIP")) for one or more service devices (e.g., a VoIP telephone) associated with the CM 16.

Clearly, none of the above disclosure mentions anything of pressing a button, let alone, “pressing a button associated with the requested service at the first client during the packet-based telephony call session to initiate the service request message.” Accordingly,

for at least this additional reason, Claim 12 is allowable as is Claims 27 for analogous reasons.

Section 103 Rejections

Claims 7-11, 21, 23-26, 32-35, 38, and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fijolek* as applied to Claims 1, 14, 29, and 36 above, and further in view of U.S. Patent No. 6,477,708 issued to Bittinger ("*Bittinger*"). Claims 13 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fijolek* as applied to Claims 1 and 14 above, and further in view of U.S. Patent No. 5,854,894 issued to Lancaster, et al. ("*Lancaster*"). These rejections are moot because the independent claims are allowable as identified above.

Failure to Establish Prima Facie Rejection

Applicant submits that the above indicated errors in failing to establish a *prima facie* case of anticipation are clear errors of law as defined by the Official Gazette Notice of July 12, 2005, establishing the procedure for the Pre-Appeal Brief Request for Review, and if maintained, would clearly be overturned by a Pre-Appeal Panel.

Request for Evidentiary Support

Should any of the above asserted rejections be maintained, Applicant respectfully requests appropriate evidentiary support. Additionally, if the Examiner is relying upon "common knowledge" or "well known" principles to establish the rejection, Applicant requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an "Official Notice" or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Applicant reserves the right to discuss the distinctions between the applied art and the claims in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the anticipation and obviousness rejections.

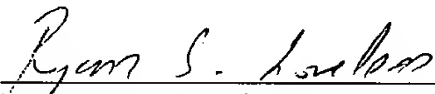
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Ryan S. Loveless, Attorney for Applicant, at the Examiner's convenience at (214) 953-6913.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: December 31, 2007

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